

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Serial No. | : | 10/082,857 |
| Confirmation No. | : | 4953 |
| Filing Date | : | OCTOBER 19, 2001 |
| Group Art Unit | : | 2134 |
| Examiner | : | AUBREY WYSZNSKI |

**RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF
On Appeal from Group Art Unit 2134**

Date: July 13, 2007

Responsive to the Notice of Non-Compliant Appeal Brief dated June 22, 2007, Appellants provide herein a replacement “Summary of the Claimed Subject Matter” in accordance with MPEP 1205.03, by providing only the corrected section of the appeal brief. Appellants further provide a replacement section VII to conform the remarks to the changed “Summary of the Claimed Subject Matter” in section V.

Replacement section V starts on page 2.

Replacement section VII starts on page 3.

Replacement section V:

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed invention, as recited in claim 1, is directed to a rendering device (110, Figs. 1 and 2, page 6, lines 27-33; page 4, lines 1-20; page 6, lines 3-11). The rendering device includes a receiving means for receiving a content item comprising at least a video portion, in which portion extra information is embedded (111, Figs. 1, page 4, lines 2-20; page 6, lines 3-11), decoding means for decoding the extra information from the video portion (112, Figs. 1, page 4, lines 2-4 and lines 12-20; page 6, lines 3-11), embedding means for embedding the extra information in an audio signal (113, Figs. 1, page 4, lines 2-4 and lines 19-28; page 5, lines 13-18; page 6, lines 3-11), and rendering means for rendering the audio signal, wherein said video portion is of a different type from said audio signal (114, Figs. 1, page 4, lines 2-4; page 5, lines 13-21; page 6, lines 3-11).

The claimed invention, as recited in claim 7, is directed to an arrangement for distributing a content item (Fig. 1, page 4, lines 1-20). The arrangement comprising: a content provider (Fig. 1, page 4, lines 1-28) arranged for embedding extra information in a video portion of the content item and for making the content item with said embedded extra information available for reception by a rendering device (110, Figs. 1 and 2, page 6, lines 27-33; page 4, lines 1-20; page 6, lines 3-11), wherein the rendering device comprises: a receiver configured to receive the content item (111, Figs. 1, page 4, lines 2-20; page 6, lines 3-11), a decoder configured to decode the extra information from the video portion (112, Figs. 1, page 4, lines 2-4 and lines 12-20; page 6, lines 3-11), an embedding module configured to embed the extra information in an audio signal (113, Figs. 1, page 4, lines 2-4 and lines 19-28; page 5, lines 13-18; page 6, lines 3-11), and a rendering module configured to render the audio signal, wherein said video portion is of a

different type from said audio signal (114, Figs. 1, page 4, lines 2-4; page 5, lines 13-21; page 6, lines 3-11).

Replacement section VII

VII. ARGUMENT

Appellant respectfully traverses the rejection in accordance with the detailed arguments set forth below.

A. Claims 1-7 are not properly rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

1. Claim 1

With regard to independent claim 1, appellant respectfully submits that the Office has not established a *prima facie* case setting forth on the record why the invention is not eligible subject matter, as is required by MPEP 2106 IV.

In the final Office Action, paragraph 6, the Examiner argues that the claims lack a structural relationship [causing them] to be entirely implemented in software and not [to] include an underlying medium. The Examiner points to page 3, lines 31-33 of appellant's specification to support this assertion.

Appellant previously pointed out that it is improper to read descriptions of illustrative embodiments into the claims as limitations. The language of the specification including "some features" and "are typically" is in fact permissive language in that it describes a situation where the elements may be implemented in software, but does not require it.

Appellant submits that that Examiner has not considered the totality of the evidence as required by the MPEP 2106 which recites: “USPTO personnel should review the totality of the evidence (e.g., the specification, claims, relevant prior art) before reaching a conclusion with regard to whether the claimed invention sets forth patent eligible subject matter. USPTO personnel must weigh the determinations made above to reach a conclusion as to whether it is more likely than not that the claimed invention as a whole either falls outside of one of the enumerated statutory classes or within one of the exceptions to statutory subject matter.” (emphasis added).

Claim 1, the rendering device, is clearly directed to patentable subject matter. Examples of the rendering device are set forth in appellant’s specification. For example, page 6, lines 27-31 describes: “Using a network operator, the content is transported over distribution network 203 to the rendering device 110, which can be realized as a set-top box at a consumer’s house, but can also be a public address system in any location. The rendering device 110 is arranged to play out the content over audio output module 115 and video output module 116.” (Emphasis added).

These examples, a set-top box and public address system, are patentable subject matter. One skilled in the art would readily understand that either of these examples, for example the set-top box, is not “entirely implemented in software” as argued in paragraph 6 of the final Office Action. One skilled in the art would certainly understand that a set-top box typically includes components such as a microprocessor/controller, memory, custom components, discrete components, a receiver for receiving input signals, an output unit for providing transformed input signals to output devices, such as video 118 or audio 115. A person of ordinary skill in the art would readily appreciate that the modules of the rendering device, may be implemented in

software, hardware, or combinations thereof, and accordingly, the elements of the claims should be understood as such.

Furthermore, as pointed out by the Examiner, appellant's specification describes, on page 3, lines 31-11, that some of the features are typically implemented in software (emphasis added). Appellant's specification uses language which is not limited to software implementation and does not require it.

In the "Response to Arguments," paragraph 4 of the final Office Action, the Examiner argues that applicant does not point to a description in the specification of the various means recited in the claims. However, one skilled in the art would recognize the various embodiments of the receiving module 111. For example, as described in the specification, the receiving module may be implemented in a set-top box to receive content, for instance a television program, a movie, a video clip, etc, which is typically received from the Internet, a satellite feed, home network, broadcast organization, or local storage. One skilled in the would readily implement such a receiving module in hardware or combination of microprocessor/controller, memory as typically found in a set-top box. One skilled in the art also readily understands the invention can be implemented in Programmable Array Logic devices or any of the multitude of available programmable or custom devices which maybe typically included in a hardware device such as a set-top box or PA system.

It is respectfully submitted that the Examiner has not considered the totality of the evidence, including the specification, claims, and relevant prior art before reaching a conclusion with regard to whether the claimed invention sets forth patent eligible subject matter. Clearly the present claims are more likely than not to be within the enumerated statutory classes of patentable subject matter.

In view of the foregoing, the Office has not met its requisite threshold of burden in establishing a *prima facie* setting forth on the record why the invention is not eligible subject matter. Accordingly, appellant respectfully requests reversal of the rejection of claim 1.

2. Claim 7

The Examiner has rejected independent claim 7 with the same arguments as used for the rejection of claim 1. In response Appellant essentially repeats the above arguments set forth for claim 1.

Additionally, claim 7 is directed to an arrangement for distributing a content item. Claim 7 clearly recites structural elements, for example a receiver, a decoder, an embedding module, and a rendering module. One skilled in the art would certainly understand that, for example a receiver, typically may include components such as a microprocessor/controller, memory, custom components, and discrete components,. The Examiner is reading features described in the specification into the claims. Appellant submits the Office has not met its requisite threshold of burden in establishing a *prima facie* setting forth on the record why the invention is not eligible subject matter. Accordingly, appellant respectfully requests reversal of the rejection of claim 7.

3. Claims 2-6

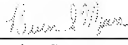
Claims 2-6 depend from claim 1 and are directed to the rendering device. These claims are likewise directed to patentable subject matter and the rejection of these claims should be reversed.

CONCLUSION

In light of the above replacement sections V and VII, Appellants respectfully submit the Appeal Brief is corrected and should be accepted.

Respectfully submitted,

Date: July 13, 2007

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